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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/921,204 | 08/02/2001 | Christopher S. Autterson | AAS104A | 5914 |
| 7590 04/06/2005 WEINER & BURT, P.C. P.O. BOX 186 HARRISVILLE, MI 48740 | | | EXAMINER PICKETT, JOHN G | |
| | | | ART UNIT 3728 | PAPER NUMBER |

DATE MAILED: 04/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/921,204

Applicant(s)

AUTTERSON, CHRISTOPHER S.

Examiner

Gregory Pickett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office action acknowledges the applicant's Amendment D, submitted 22 December 2004. Claims 1 and 11 are pending in the application.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

3. Claims 1 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ford (US 2,054,596) in view of Zimmerman (US 2,362,181) and Jenniches (DE 27 23 357 A; PTO translation provided with this Office Action).

Regarding claim 1, Ford provides a shipping/packing carton having the shape of a parallelepiped (Figure 1), and visibly printing directly on a first predetermined area of the outer carton surface of the shipping/packaging carton a first visible advertisement for a first product contained within the carton (as shown, Figures 1-4).

As to the corrugated cardboard material, Zimmerman discloses that corrugated cardboard was a known material in the shipping/packaging art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to form the carton of Ford from a corrugated cardboard in order to improve container wall strength. It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

As to the first party owning said shipping/packaging carton, It would have been obvious to one of ordinary skill in the art at the time the invention was made for the first party to own the package so as to reduce the number of parties to which profit must be distributed.

Ford-Zimmerman lacks, or does not expressly disclose the provision of a second advertisement.

Jenniches teaches visibly printing directly on a second predetermined area of the outer carton surface of the shipping/packaging carton a second visible advertisement for a second product of a second party separate and distinct from said first party, which second product is not contained in or part of the carton (see Derwent Abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the carton of Ford-Zimmerman with a second advertisement as taught by Jenniches in order to provide an additional source of income for the first party.

As to the first and second visible advertisements being both visibly printed on the shipping/packaging carton at the same time, Jenniches teaches outfitting the printing pales with the advertising imprint (see PTO translation page 2, Achievement of the Objective). It would have further been obvious to one of ordinary skill in the art at the time the invention was made to print the advertisements simultaneously in order to reduce the steps in manufacturing.

Jenniches teaches the second visible advertisement printed on a second predetermined area of the shipping/packaging carton which would otherwise be a blank

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area or void of any visible printed details and allotted by the first party (see PTO translation, page 2, Purpose).

As neither Ford, Zimmerman, nor Jenniches teaches the first party buying the second visible advertisement, this limitation is deemed inherent.

Jenniches discloses the first party determining the size and location of the second visible advertisement on the shipping/packaging carton (see PTO translation, page 2, Purpose).

Jenniches teaches the second visible advertisement printed in the otherwise blank area on a front, back, side, top or bottom of the shipping/packaging carton.

As the size of the carton limits the overall size of the advertisements, the size of the second advertisement is determined, at least in part, by the carton size.

As to claim 11, the carton of Ford-Zimmerman-Jenniches discloses the claimed invention by presentation.

4. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kapp (US 5,246,161) in view of Zimmerman (US 2,362,181).

Claim 11 is a product-by-process claim.

Kapp discloses a shipping/packaging container (10) with first advertisement (indicia on panel 14) in a first predetermined area and second advertisement (indicia on panel 12) in a second predetermined area.

As to the corrugated cardboard material, Zimmerman discloses that corrugated cardboard was a known material in the shipping/packaging art. It would have been

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obvious to one of ordinary skill in the art at the time the invention was made to form the carton of Kapp from a corrugated cardboard in order to improve container wall strength. It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Kapp-Zimmerman discloses the claimed invention except for the specific arrangement and/or content of indicia (printed matter) set forth in the claim(s). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the indicia in the claimed arrangement and content since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of advertisement does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter, e.g. indicia on panels 12 and 14, and the substrate, e.g. the box, which is required for patentability.

As to the ownership of the indicia, the ownership and the affiliation of the parties owning said indicia are deemed an intended use. It has been held that a recitation with respect to the manner in which the claimed apparatus is intended to be employed does

not differentiate the claimed apparatus from the prior art apparatus satisfying the claimed structural limitations. *Ex Parte Masham*, 2 USPQ2d 1647 (1987). The only structure currently claimed is a carton with two forms of indicia in two locations.

As to the size of the indicia, Kapp-Zimmerman discloses the claimed invention except for who or what determines the size and location. It would have been an obvious matter of design choice to change the size of the advertisement or to select the size based upon the container size, in order to make one indicia more prominent than the other. Such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). The provision of who determines the size is deemed an intended use. It has been held that a recitation with respect to the manner in which the claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus satisfying the claimed structural limitations. *Ex Parte Masham*, 2 USPQ2d 1647 (1987).

As to the simultaneous printing, the method of forming the device is not germane to the issue patentability of the device itself. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Response to Arguments

5. Applicant's arguments with respect to claim 1 and the milk carton/Bichaylo et al reference, filed 22 December 2004, have been fully considered. While the examiner does not concede the points made by the applicant, the arguments are rendered moot by the amendment to include parallelepiped limitations and the new ground(s) of rejection made in view of newly found prior art, Ford and Jenniches.

6. Applicant's arguments, see page 10, second and third paragraph, filed 22 December 2004, with respect to claim 11 have been fully considered and are persuasive. The rejection of claim 11 based on MacGuire has been withdrawn.

7. Applicant's arguments with respect to claim 11 and the Kapp reference, filed 22 December 2004, have been fully considered but they are not persuasive. The applicant presents the following points:

that the printed matter for the first advertisement is "for a first product of a first party owning said shipping/packaging carton"; nor

that the printed matter for the second advertisement is "for a second product of a second party separate and distinct from said first party, which second product is not contained in or part of said carton"; nor

that the "second visible advertisement is provided by said second party to said first party without said first party buying said second visible advertisement"; nor

that there is even a second party advertising a second product which is not contained in or part of the carton;

A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably

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distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

In response to the applicant's arguments with respect to *In re Gulack*, mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Ownership of the indicia is deemed an intended use and does not impart the functional relationship necessary for patentability. Even considering, *arguendo*, that that an advertisement imparts a functional relationship with the substrate, Kapp anticipates advertisements (see Col. 3, lines 3-6). The ownership and provision of the advertisement is deemed an intended use. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within


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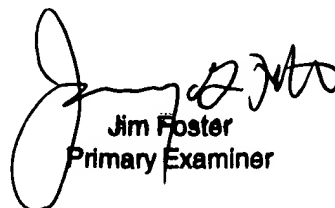
TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 571-272-4560. The examiner can normally be reached on Mon-Fri, 11:30 AM - 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Greg Pickett
Examiner
1 April 2005


Jim Foster
Primary Examiner